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Ronald P. Doyle

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EXAMINER

DIVECHA, KAMAL B

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte:* RONALD P. DOYLE,  
DAVID L. KAMINSKY, and DAVID M. OGLE

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Application No. 09/943,562  
Technology Center 2400

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Mailed: April 14, 2009

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Before KRISTA ZELE *Deputy Chief Appeals Administrator*  
ZELE, *Deputy Chief Appeals Administrator*.

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received by the Board of Patent Appeals and Interferences on November 12, 2008. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner to address the following matters requiring attention prior to docketing.

APPEAL BRIEF: ARGUMENT

A review of the file finds that the Appellants have not provided the necessary and proper heading for the section on arguments in the Appeal Brief filed December 13, 2007. Specifically, the Appeal Brief has no section heading labeled “Argument”. *See also Manual of Patent Examining Procedure* (MPEP) § 1205 (8<sup>th</sup> ed. Rev. 6, Sept 2007) for details.

APPEAL BRIEF: SUMMARY OF CLAIMED SUBJECT MATTER

The Appeal Brief filed December 13, 2007 is not in compliance with 37 C.F.R. § 41.37(c), effective September 13, 2004.

According to 37 C.F.R. § 41.37(c)(v), an Appeal Brief must include the following:

(v) *Summary Of Claimed Subject Matter*. A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which must refer to the specification by page and line number, and to the drawing, if any, by reference characters. While reference to page and line number of the specification *\*\*>requires<* somewhat more detail than simply summarizing the invention, it is considered important to enable the Board to more quickly determine where the claimed subject matter is described in the application. *>*For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of 37 CFR 41.37(c)(1)(vii), every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

The “Summary of Claimed Subject Matter” appearing on pages 2 to 7 of the Appeal Brief is deficient because it does not separately map independent claims 45, 74, 82, 86, 87 and 96 to the Specification’s page and line numbers; instead Appellants mapped the independent claims to the paragraph numbers of United States Patent Publication Number 2003/0046335. Correction is required.

MPEP § 1205.03 states in part:

(B) When the Office holds the brief to be defective solely due to appellant’s failure to provide a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v), an entire new brief need not, and should not, be filed. Rather, a paper providing a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v) will suffice. Failure to timely respond to the Office’s requirement will result in dismissal of the appeal. See MPEP § 1215.04 and § 711.02(b).

### CONCLUSION

Accordingly, it is ORDERED that the application be returned to the Examiner to:

- (1) hold the Appeal Brief filed on December 13, 2007 defective, as required by 37 C.F.R. § 41.37(d);
- (2) notify Appellants to submit a paper providing the proper heading for the section on arguments in the Appeal Brief;
- (3) notify Appellants to submit a paper correcting the Appeal Brief’s “Summary of Claimed Subject Matter” under 37 C.F.R. § 41.37(c)(1)(v);

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- (4) acknowledge and consider any paper submitted by Appellants to correct the Appeal Brief; and
- (5) finally, for such further action as may be appropriate.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

KZ/BIM

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